

REMARKS

Claims 1-10 are pending and rejected in the application. By this Amendment, Applicants have amended Claim 1.

I. Rejection of claims 1-10 under 35 U.S.C. § 112

The Office Action rejected claims 1-10 under 35 U.S.C. § 112, second paragraph. More particularly, the Office Action rejected claims 1-10 because the Examiner was concerned that there was potential inconsistency among the following terms: "an insert" (cl 1, ln 1); "a blank metal substrate" (cl 1, lns 3-4); "a metal substrate" (cl 1, ln 4); "the insert" (cl 1, ln 5 and 6); "the blank metal substrate" (cl 1, lns 7 and 8); and "said insert" (cl 2, lns 1 and 2; cl 3, lns 1 and 3; cl 4, ln 1; cl 6, lns 1 and 2; cl 8, ln 3; and cl 10, ln 2).

Applicant has amended claim 1 to show clarification in the use of "metal substrate" and its transformation into an "insert" to address the concerns raised by the Examiner. Applicants respectfully submit that in view of the amendment to claim 1, the rejection is now addressed.

II. Rejection of claims 1-5 under 35 U.S.C. § 102(b)

Claims 1-5 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,096,228 to Decker ("Decker"). The rejection is respectfully traversed.

The Office Action asserts that Decker discloses "the claimed process as evidenced at col 2, lns 40-50; col 3, lns 4-7 and 17-18; col 4, lns 36-60; col 5, lns 7-30; and figs 1-5" (see Office Action at page 2, item 3). To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹ "The identical invention must be shown in as complete detail as is contained in the ... claim."²

The rejection of claims 1-5 is respectfully traversed for at least three reasons. First, Decker does not teach the use of blank metal substrate. Instead, compressible component 11 is formed from rubber and rubberlike materials, compressible asbestosboard or fiberboard materials, cork, composites and the like. (Column 3, lines 17-29). Second, Decker does not

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

teach the formation of an insert from a blank as recited explicitly in the claim. Instead, “component 11 is preformed, as by die cutting, stamping and the like.” (Column 4, lines 13-14). The creation of a groove within component 11 during molding is simply to minimize flashing during molding. It has nothing to do with the overall shape and function of the component. In fact, if the groove were placed within the component before the molding operation, the flashing would not be minimized. Thus, the creation of a groove during molding is not intended to reduce the number of forming operations; and as already noted Decker explicitly requires such pre-forming operations prior to the final molding step. Third, Decker does not teach the supplying of an elastomeric material to selected predetermined portions of the insert and then curing it. Component 12 is taught as being the “rigid component” as contrasted with the “compressible component”, which as noted above, is rubberlike. Thus, an elastomeric material is not molded as required by claim 1.

In contrast, the claimed invention reduces the number of forming operations required to make a final product by combining a metal forming process with a molding process such that a blank metal substrate is shaped into a final insert while an elastomeric material is supplied and then cured into its final shape.

For each of these reasons, claim 1 is patentable over the prior art of record.

While claims 2-5 are patentable since claim 1 is patentable, they are also independently patentable. For example, claim 3 recites that the insert comprises a metallic body and includes an elastomeric sealing bead bonded to said body, wherein said body is plastically deformed via said application of said second force to sheape said insert. Decker teaches away from the insert comprising a metallic body as well as an elastomeric sealing bead bonded to said body. Claim 4 explicitly requires that the insert be manufactured in a single mode process that includes the shaping of the insert body and the molding of the bead. Decker teaches the use of multiple processes and not a single mode process.

III. Rejection of claims 6-10 under 35 U.S.C. §103(a)

Claims 6 -10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Decker. The rejection is respectfully traversed.

The Office Action acknowledges that Decker does not teach “*using an insert having radially extending arms; using an insert having arms wherein at least one of the arms has an offset elbow; using an elbow that provides a connection between the arm and a shoulder portion of the insert wherein the shoulder portion is contiguous with the peripheral edge of*

the closed loop of the insert" (see Office Action at page 3 lines 9 – 13). Thus, the Examiner simply asserts that it a mere matter of design choice. Such an assertion is inappropriate. The Examiner may not merely state that a specific feature is a design choice but must provide reasoning as to why the feature is a design choice. *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995). Moreover, the statement that the "claimed design is well-known in the gasket art" is completely wrong.

Nowhere in the prior art of record is there a teaching of the limitations of claims 1-5 as discussed above. Moreover, even if Decker were somehow applicable, at most it teaches the formation of a simple groove. The ability to create a metal insert while molding an elastomeric material that has a sealing body portion defining a closed loop and further comprising radially extending arms is an explicit recitation of the complexity of the die operation taking place within the mold. It is completely contrary to anything known in the art. It is the operation that is being claimed and not the finished product so the claimed design is not at all known in the gasket art.

The same comments are applicable to claims 7-9, wherein each of the dependent claims include a further level of complexity as to the shape of the final insert and elastomeric material that is cured. Thus, claims 6-10 are patentable over the prior art of record independently of the fact that they are dependent on claim 1.



IV. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1187 from which the undersigned is authorized to draw.

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(the 3rd falling on a Saturday)

Respectfully submitted,

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